



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,326	10/10/2003	Michael D. Ellis	UV-35 Cont.	9238
75563 7590 02/22/2008 ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER PENG, FRED H	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 02/22/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/684,326

Applicant(s)

ELLIS ET AL.

Examiner

Fred Peng

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 04/23/2004, 10/03/2005
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims (54, 55, 57, 58, 59, 60, 61, 62, 63); (65, 66, 68, 69, 70, 71, 72, 73, 74) are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims (1, 5, 13, 14, 15, 17, 18, 19, 20) of U.S. Patent No. US6, 665, 869. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is notoriously well known in the art to use a program guide application interface to receive a request from a user and direct to execute a program guide or non-program guide application.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 76-86 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Art Unit: 2623

Claims 76-86 define a machine-readable medium embodying functional descriptive material. However, the claims do not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized"). The examiner suggests amending the claim to embody the program on "computer-readable medium encoded with computer executable instructions" or equivalent in order to make the claim statutory. **Any amendment to the claim should be commensurate with its corresponding disclosure.**

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 43-86 are rejected under 35 U.S.C. 102(e) as being anticipated by LaJoie et al (US 2005/0015804).

Regarding Claims 43, 54, 65 and 76, LaJoie discloses a system (FIG.1) with corresponding method and machine-readable media (FIG.3, item 32) for allowing non-guide applications implemented on user television equipment (FIG.3, items 6, 59, 60) to use device resources within the user television equipment and program guide resources associated with an

Art Unit: 2623

interactive television program guide (FIG.9) implemented on the user television equipment, the system comprising:

means for receiving, with a program guide application interface (FIG.10, item 224), a request directly from a requesting non-guide application to use one of a device resource (set a VCR Timers) and a program guide resource (schedule to record a program via a tuner); and

means for directing the request to the one of the device resource (request to set VCR timer) and the program guide resource (request the tuner to receive a schedule program) using the program guide application interface.

Regarding Claims 44, 55, 66 and 77, LaJoie further discloses the device resource is selected from the group consisting of an on-screen display resource (FIG.3, item 46), a front-panel display resource (54), a user input interface resource (59), a tuner resource (42), a communications circuitry resource (43, 58), a set-top box resource (6), and a memory resource (32).

Regarding Claims 45, 56, 67 and 78, LaJoie further discloses the program guide resource is selected from the group consisting of a tuning resource (FIG.10, 230; tuning favorite channels), a parental control resource (FIG.10, 228), a graphics library resource (guide display), a pay program purchasing resource (234), a program guide database access resource (222), a scheduling resource (FIG.14), and a program guide menu resource (322).

Regarding Claims 46, 57, 68 and 79, LaJoie further discloses maintaining a registered application list (FIG.10, items 228-238).

Regarding Claims 47, 58, 69 and 80, LaJoie further discloses processing control requests from the interactive television program guide (FIG.10, item 228, 230) and non-guide applications (232, 234, 236, 238).

Regarding Claims 48, 59, 70 and 81, LaJoie further discloses directing user input to the interactive television program guide and non-guide applications (FIG.10, use remote keys to select 136 or navigate with arrow keys 128).

Regarding Claims 49-50, 60-61, 71-72 and 82-83, LaJoie further discloses coordinating multiple requests to utilize the device resource and program guide resource (Para 114 lines 1-12).

Regarding Claims 51, 62, 73 and 84, LaJoie further discloses suspending the operation of one of the applications (Para 114 lines 6-12; suspending one program when schedule more than one programs to record).

Regarding Claims 52, 63, 74 and 85, LaJoie further discloses resolving conflicts between applications that desire access to a user input device at the same time (Para 114 lines 23-28; recorder is a user input device; resolving conflicts to record).

Regarding Claims 53, 64, 75 and 86, LaJoie further discloses resolving conflicts between applications that request access to the same remote control keys of a remote control at the same time (FIG.12, 272; Para 114 lines 12-25; request same key to confirm subscription of PPV or cancel recording).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Peng whose telephone number is (571) 270-1147. The examiner can normally be reached on Monday-Friday 09:00-18:30.

Art Unit: 2623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fred Peng
Patent Examiner

Vivek Srivastava
Supervisory Patent Examiner

A handwritten signature in black ink, appearing to read 'Vivek Srivastava', with a stylized flourish at the end.

VIVEK SRIVASTAVA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600